

Customer No. 27061
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Patent
Attorney Docket No. GEMS8081.028

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Vikram Singh et al.
Serial No. : 09/468,752
Filed : December 21, 1999
For : METHOD AND APPARATUS FOR SCREENING A POTENTIAL
CUSTOMER AND ASSIGNING AN ACCOUNT NUMBER TO
THE POTENTIAL CUSTOMER ACROSS A GLOBAL
COMPUTER NETWORK
Group Art No. : 3627
Examiner : Andrew J. Rudy

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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37 CFR 1.8(a) **37 CFR 1.10**
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PETITION UNDER 37 CFR 1.701 and 37 C.F.R §1.181 REQUESTING
CALCULATION OF PATENT TERM EXTENSION UNDER 35 U.S.C. §154(b)

Dear Sir:

Applicant hereby requests extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000) under §1.701, and as applicable, reconsideration and recalculation of the Patent Term Extension under 35 U.S.C. §154(b) for U.S. Application No. 09/468,752 based on the following remarks.

REMARKS

Applicant's U.S. Patent Application No. 09/468,752 was filed December 21, 1999. More than ten years after the filing date of the application, a Notice of Allowance and Notice of Allowability was mailed August 27, 2010. The August 27, 2010 Notice of Allowance included a Determination of Patent Term Extension under 35 U.S.C. 154(b), but stated that “[t]he Patent Term Extension is 0 day(s).” *See Notice of Allowance*, August 27, 2010, p. 3. However, Applicant believes that it is entitled to a Patent Term Extension under 35 U.S.C. 154(b), as will be set forth herein.

As the subject application was filed prior to May 29, 2000, Applicant is aware that the Patent Term Adjustment under 37 CFR 1.702 is not strictly applicable. However, 37 CFR 1.701 sets forth several circumstances under which patent applications filed on or after June 8, 1995 and before May 29, 2000 are eligible for Patent Term Extension. Namely, 37 CFR 1.701 states:

[a] patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to: . . . (3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal Court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

37 CFR 1.701. Applicant believes that the subject application was under appellate review since at least March 3, 2003, when Applicant filed a Notice of Appeal, and that the Notice of Allowance and Notice of Allowability mailed August 27, 2010 was, in effect, a reversal of an adverse determination of patentability previously set forth by the Examiner. As such, Applicant respectfully requests reconsideration and recalculation of Patent Term Extension under 35 U.S.C. 154(b). Below is a brief explanation of the prosecution history in support of this Petition.

As noted above, the subject application was filed December 21, 1999. After receiving a two Non-Final Office Actions, a Final Office Action, and an Advisory Action, Applicant filed a Notice of Appeal on March 3, 2003, followed by a timely Appeal Brief on May 5, 2003. The Examiner issued a Notice of Non-Compliant Appeal Brief on June 25, 2003, to which Applicant replied with a timely Amended Appeal Brief on July 7, 2003. However, subsequent to the July 7, 2003 Amended Appeal Brief, the Examiner submitted yet another Non-Final Office Action on September 16, 2003. Upon receiving the September 16, 2003 Non-Final Office Action,

Applicant timely filed a request to reinstate the appeal, along with a Supplemental Appeal Brief on December 16, 2003. Nearly three years later, and with no intervening actions from the Examiner or responses Applicant's numerous status inquiries, Applicant received a Notice of Abandonment on October 6, 2006.

In response to the October 6, 2006 Notice of Abandonment, Applicant filed a Request to Withdraw Abandonment on November 2, 2006. However, for nearly three years, and despite numerous status inquiries to the USPTO, Applicant never received a Decision on the November 2, 2006 Request to Withdraw Abandonment. As such, Applicant filed a Renewed Petition to Withdraw Abandonment on October 15, 2009 and made repeated telephone inquiries. The Renewed Petition to Withdraw Abandonment was ultimately granted by the Office in a Decision dated May 21, 2010, and Applicant received a Notice of Allowance and Notice of Allowability on August 27, 2010.

As is evidenced by the brief explanation of the application's prosecution history above, Applicant timely and diligently filed all necessary responses related to the application, particularly those related to the patent appeals proceeding. However, due to the Examiner's unreasonable delay and outright unjustified issuance of a Notice of Abandonment, Applicant has been forced to endure years of unnecessarily prolonged prosecution, even after Applicant initiated the appeal on March 3, 2003.

With Applicant's timely filed Notice of Appeal on March 3, 2003, followed by timely filed Appeal Briefs, Applicant did all it could do to move the Application to the Board of Patent Appeals and Interferences. Despite these facts, the Examiner never filed an Examiner's Answer. The term of this patent should not be adversely shortened because of the Examiner's failure to follow the appeals process.

This application was under appellate review from the point that Applicant filed the Notice of Appeal on March 3, 2003, followed by timely filed Appeal Briefs. Accordingly, per 37 CFR 1.701, Applicant is entitled to an extension of patent term due to a decision reversing an adverse determination of patentability. The application was under appeal and all of the rejections were reversed with the August 27, 2010 Notice of Allowance and Notice of Allowability. As the the appeal to the Board of Patent Appeal and Interferences was filed on March 3, 2003 and the date on which a final decision in favor of Applicant was August 27, 2010, the application was under appellate review for 2734 days. Applicant respectfully requests appropriate Patent Term Extension.

Conclusion

Applicant's patent term should not be shortened due to the Office's delay. This application has been under appellate review since the filing of the March 3, 2003 Notice of Appeal and Applicant has acted with due diligence since that time. In view of the above summary of the unnecessarily prolonged appeal in this matter, Applicant respectfully requests that the Office grant this Request for Reconsideration and Recalculation of the Patent Term Extension under 35 U.S.C. §154(b).

No fee under 37 C.F.R §1.17 is believed due for this Petition.

Applicant appreciates the Office's consideration of these Remarks and cordially invites the Office to call the undersigned, should the Office consider any matters unresolved.

Respectfully submitted,

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